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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,857	09/19/2001	Yasuteru Takahama	01582/LH	9871

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FRISHAUF, HOLTZ, GOODMAN & CHICK, PC
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NEW YORK, NY 10017-2023

EXAMINER

ROBINSON, MARK A

ART UNIT	PAPER NUMBER
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2872

DATE MAILED: 05/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/955,857

Applicant(s)

TAKAHAMA ET AL.

Examiner

Mark A. Robinson

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– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 10-17 and 21-34 is/are pending in the application.
- 4a) Of the above claim(s) 21-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 10-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,6,9. 6) ☐ Other: _____

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DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of species a. (fig. 1) reading on claims 1-3 and 10-17 in Paper No. 8 is acknowledged.

Claims 21-34 are withdrawn from consideration as being drawn to non-elected subject matter.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "photographing shutter" and/or "shutter mechanisms" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Further, if these features are particular to non-elected embodiments, then applicant should so state and the claims will be withdrawn from consideration.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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Claim Rejections - 35 USC § 112

3. Claims 1-3 and 10-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors. Numerous terms lack antecedent basis, for example (in claim 2) "the position," "the TV camera," "the digital camera device," "the end surface portion," etc.

In claim 1 "the external surface" lacks antecedent basis, and it is unclear what this is in reference to (the external surface of what?). Thus it is unclear how the image output port is oriented.

In the last paragraph of claim 3 "therein" is ambiguous and it is unclear what this references.

Due to the manner in which claim 11 is written, it is unclear how the photographing shutter and shutter mechanisms are arranged, especially relative to "the light incoming side" or the "light path switching mechanism." Further, "said photo photographing device" lacks antecedent basis, and it is unclear if this refers to the previously recited "photographing device."

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The metes and bounds of what is intended to be covered by claim 12 are indefinite due to the manner in which this claim is written. The claim seems to merely recite two "spaces" located in the microscope.

In claim 13 it is unclear what is being pulled and inserted by the "light path switching lever."

In claim 14, it is unclear what is meant by making the photographing shutter "available..."

Due to the manner in which claim 15 is written the number of reflections in the microscope is unclear.

In the last paragraph of claim 17 "therein" is ambiguous and it is unclear what this references.

Inasmuch as the claims are able to be understood in light of the 112 rejections made above, the following rejection(s) apply:

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

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the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 and 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoogesteger 4770520 in view of Feinbloom 4143938 of record.

Hoogesteger shows an inverted microscope including an image output port(39) at a front side of the microscope below the eyepiece, but does not show the particular arrangement for attachment/detachment of at least one photographing device. However, Feinbloom shows a photographing device which is selectively attachable to a microscope image output port (see figs. 1 and 2). Note that specific lens units (note the first paragraph of column 4) and a light path switching mechanism(26,51,etc.) and shutters are included with the image recording devices. It would have been obvious to the ordinarily skilled artisan at the time of invention to include the photographing device arrangement of Feinbloom with Hoogesteger's microscope in order to enable recording of sample images in both still and video modes.

Regarding claim 14, although not taught by the references, position detecting sensors are well known in the art. It would have been obvious to include such in the microscope of Hoogesteger in view of Feinbloom in order to allow for control

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of the switching mechanism and thus imaging by a particular photographing device.

Regarding claim 15, although not specifically taught by the references, the number of reflections required for proper image orientation is well known and within the level of ordinary skill in the art. It would have been obvious at the time of invention to incorporate either an even or odd number of reflections in the microscope of Hoogesteger in view of Feinbloom in order to ensure proper image reversal or orientation.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Meyer et al 4210384 and Endou et al 5777783 show inverted microscopes with photographing devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (703) 305-3506.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached at (703) 308-1687. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

MR

5/7/03


MARK A. ROBINSON
PRIMARY EXAMINER